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10/577,158

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Rached Ksontini

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EXAMINER

VAUGHAN, MICHAEL R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,158	Applicant(s) KSONTINI ET AL.	
	Examiner MICHAEL R. VAUGHAN	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/26/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The instant application having Application No. 10/577,158 is presented for examination by the examiner. Claims 21-40 are pending. Claims 21-40 have been amended.

Response to Amendment

Claim Objections

Claim objections with respect to claims 21 and 26 are hereby withdrawn on the basis of the amendments.

Specification

The newly supplied abstract is acknowledged. The objection to the abstract is hereby withdrawn.

Claim Rejections - 35 USC § 112

Claims 25 and 34 have been amended to overcome the previous rejection.

Response to Arguments

Applicant's arguments filed 12/09/08 have been fully considered but they are not persuasive. Examiner appreciates the arguments and has carefully weighed the points

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with the prior art but respectfully disagrees with respect to the Parker reference not teaching the newly amended limitation. Specifically, Applicant has alleged that Parker does not teach "selectively activating or deactivating, by the security module, at least one resource as data or functions of said security module by executing instructions". However, to point out the difference, Applicant has relied on specific limitations only found in the specification.

Applicant has pointed out various differences with Parker and the invention as described in the specification. However, Examiner notes that those differences as alluded to are not present in the *claimed* invention. The independent claims are void of those limitations. Examiner does agree that the Parker reference basically teaches unlocking/locking the phone via the SIM, with one difference though. Parker does teach a third mode whereby the phone may be remotely deactivated such that it can only send out emergency calls. This implies there are at least three modes to choose from: a locked mode, an emergency only mode, and an unlocked mode; see column 11, lines 1-8. The phone of Parker can also be re-locked for any reason. Also, Parker suggests a fourth possible mode for a permanent type of unlocking whereby the phone can be used on a different network. This mode is distinguished from the previous unlocked mode in which previous is a normal operating mode on the network.

Therefore, the modes of Parker are selectively chosen based on the status of the phone and user. Examiner is interpreting the calling service of the phone as the "at least one resource as data or functions" in the claim language. When the phone is prohibited from making normal calls that resource is disabled. The phone's functionality

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is not completely disabled in that it still can make emergency calls. This implies some minor software programming restricting it from making normal calls.

Applicant has alleged that the Parker reference does not teach selectively activation or deactivation, but Examiner finds support for this limitation as discussed above. The limitation as written does not narrow it the scope to any particular type of resource. Applicant has given examples of types of functions which can be deactivated but those are merely examples. Examiner would agree that the Parker teaching does not teach deactivating specific services such as: remote banking operations, electronic commerce, and access to multimedia content, while maintaining the normal calling features. The Parker reference does however limit the cryptographic functions of the phone when it is the locked mode. The scope of the claim is as such that it reads on the teachings of Parker because disabling the phone's calling service is "at least one resource".

If Applicant wishes to further amend the claim to better clarify the scope of selectively activating or deactivating functions, Examiner has listed one reference for consideration on the enclosed PTO-892 form.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cryptogram including its contents must be shown or the feature(s) canceled from the claim(s).

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Examiner now sees the little bubble that Applicant has pointed to. However, the drawings do not make it clear to follow the method of claim 1. If the Applicant had not explicitly stated that the bubble was the cryptogram, Examiner would not have ever made that conclusion. The bubble with a 'J' beside it (with no arrow indicating the relationship) is unclear. Moreover, there are dots inside the bubble which are ambiguous as well. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-36 and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,864,757 to Parker.

As per claim 21, Parker teaches a method for managing the security of applications with a security module functioning in an equipment connected to a network, said network being managed by a control server of an operator, said applications using resources as data or functions stored in a security module [SIM] locally connected to said equipment, comprising the following preliminary steps:

reception of data comprising at least the type and software version of the equipment (col. 6, line 46) and the identity of the security module (col. 1, lines 50-55), via the network, by the control server (col. 8, lines 21-25),

analysis and verification by the control server of said data (col. 8, lines 26-28),

generation of a cryptogram (col. 8, lines 41-44) from the result of the verification of said data, and transmission of said cryptogram, via the network and the equipment, to the security module (col. 8, lines 60-65), said method further comprises steps wherein the security module analyses the received cryptogram and activates, respectively

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deactivates the resources as data or functions used by at least one application installed in the equipment, said cryptogram comprising the instructions [necessary keys] conditioning [lock/unlock] the functioning of the application [application to make a call] according to criteria established by the supplier of said application and/or the operator and/or the user of the equipment (col. 9, lines 1-8).

As per claim 22, Parker teaches the equipment is a mobile equipment of mobile telephony (see abstract).

As per claim 23, Parker teaches the network is a mobile network of the GSM, GPRS or UMTS type (col. 1, line 36).

As per claim 24, Parker teaches the security module is a subscriber module of a SIM card type inserted into the mobile equipment of mobile telephony (col. 1, line 50).

As per claim 25, Parker teaches the identification of the set mobile equipment / subscriber module is carried out from the identifier of the mobile equipment and from the identification number of the subscriber module pertaining to a subscriber to the mobile network (col. 8, lines 55-65).

As per claim 26, Parker teaches the criteria [locked/unlocked] defines the usage limits [activate / deactivate] of an application according to the risk [key exposure] associated to said application and to the type and the software version of the mobile equipment that the operator and/or the application supplier and/or the user of the mobile equipment want to take in account (col. 9, lines 2-4). Upon activating a locked phone, Parker teaches a phone can be relocked if a key is compromised and needs to be

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changed. This process takes into account the identity information inside the phone, including the SIM.

As per claim 27, Parker teaches the activation method is carried out after each connection of the mobile equipment to the network (col. 9, line 11). A check is made at turn on to see if the device is locked. It does however bypass the rest of the activation method and goes to the authentication part of the method if the check is satisfied.

As per claim 28, Parker teaches the activation method is carried out after each of updating the software version of the mobile equipment (col. 9, lines 1-5). Anytime the phone receives a new subscriber identification code it is necessary for the handset to re-register with the base station.

As per claim 29, Parker teaches the activation method is carried out after each activation or deactivation of an application on the mobile equipment (col. 9, lines 1-5).

As per claim 30, Parker teaches the activation method is carried out after each updating of the software version of the subscriber module (col. 9, lines 1-5). Anytime the phone receives a new subscriber identification code it is necessary for the handset to re-register with the base station.

As per claim 31, Parker teaches the activation method is out after each updating of the resources on the subscriber module (col. 9, lines 1-5). Anytime the phone receives a new subscriber identification code it is necessary for the handset to re-register with the base station.

As per claim 32, Parker teaches the activation method is carried out periodically at a rate [each startup] given by the control server (col. 9, line 11).

As per claim 33, Parker teaches the activation method is carried out after each initialization of an application on the mobile application (col. 9, lines 1-5). Activation is synonymous with initialization.

As per claim 34, Parker teaches the subscriber module, prior to the execution of the instructions given by the cryptogram, compares the identifier of the mobile equipment with that previously received (Fig. 5, 172).

As per claim 35, Parker teaches the control server, prior to the transmission of the cryptogram, compares the identifier of the mobile equipment with that previously received and only initiates the verification operation if the identifier has changed (col. 8, lines 55-65). This activation is only done a second time if the SIM or any of its values change. Otherwise, the server already knows the phone is ok and does not send it a new IMSI.

As per claim 36, Parker teaches the cryptogram is made up of a message encrypted by the control server with the aid of an asymmetrical or symmetrical encryption key from a data set containing, among other data, the identifier of the mobile equipment, the identification number of the subscriber module, the resource references of the subscriber module and a predictable variable (col. 8, lines 50-59).

As per claim 38, Parker teaches the equipment is a Pay-TV decoder or a computer to which the security module is connected (col. 12, lines 60-65).

As per claim 39, Parker teaches a security module [SIM] comprising resources intended to be locally accessed by at least one application [phone calling software] installed in an equipment [cell phone] connected to a network, said equipment

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comprising reading and data transmission means comprising at least the identifier of the equipment and the identifier of the security module (col. 8, lines 21-25), said module further comprises means for reception (col. 8, lines 60-65), analysis and execution of instructions contained in a cryptogram (col. 9, lines 1-15), said instructions conditioning the functioning [unlocking/locking] of the application according to criteria predetermined by the supplier of said application and/or the operator and/or the user of the equipment (col. 9, lines 1-8).

As per claim 40, Parker teaches a subscriber module of the "SIM card" type connected to a mobile equipment (col. 1, lines 50-55).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of USP Application Publication 2003/0041125 to Salomon.

As per claim 37, Parker is silent in disclosing the subscriber module transmits to the control server, via the mobile equipment and the mobile network, a confirmation message when the subscriber module has received the cryptogram, said message

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confirming the correct reception and the adequate processing of the cryptogram by the subscriber module. Salomon teaches the subscriber module transmits to the control server, via the mobile equipment and the mobile network, a confirmation message when the subscriber module has received the packet, said message confirming the correct reception and the adequate processing of the cryptogram by the subscriber module (0056). Receipt messages or as they are usually to in the art, acknowledgement messages (ACK), are notoriously well known in the art of computer communication. ACK are used to ensure proper and reliable communication between two devices. The ACK serves to let the sender know the packet was received by the recipient so the sender can timely conclude the communication. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use the acknowledgement messages of Salomon in the method of activation of Parker so server can know that the phone received the data without error. Any type of computer communication method can benefit from ACK messages.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/Syed Zia/

Primary Examiner, Art Unit 2431